

REMARKS

Claims 1-18 are pending in the present application. Claims 13-18 are withdrawn from consideration. Claims 1-12 are rejected. Claims 3-5 are herein amended. No new matter has been entered.

Claim Rejections - 35 U.S.C. §102(b)

Claims 4-9 stand rejected under 35 U.S.C. §102(b) as being anticipated by Roetker et al. (US Patent 5,630,847).

The Examiner views cosmetics, toiletries, and medicine containing the antiseptic disinfectant as intended uses, and gives the intended uses no patentable weight. The Examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish from each other.

Specifically with respect to the “wherein” clauses, Applicants note the Manual of Patent Examining Procedure (MPEP) §2111.04, which indicates that, “The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it **cannot be ignored** in order to change the substance of the invention.” (Emphasis added.) The MPEP indicates that a “wherein” clause may be ignored when, “it simply expresses the intended result

of a process step positively recited." However, such is not the present case. Therefore, the clauses may not be ignored by the Examiner.

Claim 4 recites a cosmetically effective agent and to include the limitation "wherein said cosmetics are suitable for use on humans or animals". Claim 7 recites a medicinally effective agent and to include the limitation "wherein said medicine is medicinally effective on humans or animals". The Examiner is improperly ignoring each of these limitations.

Applicants note that Roetker et al. relates to dry cleaning compositions (in the 10th line in the column 1), and here is no disclosure that the dry cleaning composition contains the (1) "cosmetically effective agent" and (1) "medicinally agent", (2) the limitation of "wherein said cosmetics and toiletries are suitable for use on humans or animals" and (2) the limitation of "wherein said medicine is medicinally effective on humans or animals" are not also taught and suggested.

Therefore the present invention described in claims 4 to 9 is patentably distinct over the cited reference, because there is structural difference between the invention described in the amended claims 4 to 9 and the invention of Roetker et al.

Because these limitations are not taught by or inherently included in the cited reference, and because the Examiner has not presented a reference that includes these limitations, the rejection under §102 is improper. Applicants disagree with this rejection, and traverse it.

Claim Rejections - 35 U.S.C. §103(a)

Claims 1-12 are rejected under 35 U.S.C. §103(a) as being obvious over Clarkson et al. (US Patent Application 2001/0036964 A1) in view of Roetker et al. (US Patent 6,630,847) and further in view of Jensen et al. (US Patent 2,550,255).

The Examiner notes that Clarkson et al. teach an anti-microbial composition comprising polyhydric alcohol (abstract), where the preferred compounds are 1,2-hexanediol and 1,2-octanediol (section 0065). These compositions are used on the most malodorous areas of the body (section 0001), therefore requiring the use of perfumes or fragrances (section 0086).

The Examiner admits that Clarkson et al. fail to disclose specifically a composition containing a perfume or fragrance. However, the Examiner notes that Roetker et al. teach a composition containing 1,2-octanediol (col. 2, lines 30-40) and a perfume ingredient such as eugenol (col. 6, line 4), exemplified in Example I.

The Examiner admits that Roetker et al. and Clarkson et al. fail to disclose specifically a food product containing this composition. However, the Examiner notes that Jensen et al. teach anti-bacterial agents to be employed as an effective preservative for food products (col. 1, lines 34-56).

With respect to claims 4-7, the Examiner concludes that it would have been obvious to use the antimicrobial composition as taught by Clarkson et al. and Roetker et al. in food products, because one would have been motivated to use the composition taught by Clarkson et al. and Roetker et al. in food products because the anti-bacterial properties of 1,2-hexanediol and 1,2-octanediol can be used as a preservatives in food products to prevent spoilage and decomposition.

(While claims 7-9 directed to a medicine are rejected, the Examiner fails to assert a suggestion to combine the references to reach the invention of claims 7-9.)

Applicants note that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. (Manual of Patent Examining Procedure §2142). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

Applicants respectfully disagree with the rejections because there is no proper suggestion to combine the references to reach the present invention. Moreover, even if the references were properly combined, the present invention is not fully taught or suggest by the cited combination of references.

Claim 1 relates to the antiseptic disinfectant containing one or more materials selected from a group consisting of 1,2-heptanediol, 1,2-nonanediol, and 1,2-decanediol, and particular fragrance components.

Applicants note that there is no teaching in the cited combination of references of "one or more materials selected from a group consisting of 1,2-heptanediol, 1,2-nonanediol, and 1,2-decanediol". Because this limitation is not taught by even the combination of references, Applicants traverse the rejection of claim 1.

Clarkson et al. discloses an anti-microbial composition comprising polyhydric alcohol or derivative to which may be added conventional perfumes (See [0086] in Clarkson et al.), and it is disclosed in Roetker et al. that eugenol can be contained in dry cleaning compositions to cover the inherent odor of the dry cleaning composition. (See the 10th line in the column 4 in the Roetker et al.).

By referring to the above disclosures, the present invention described in the amended claim 1, thus a combination of the particular 1,2-alkanediol (i.e., 1,2-heptanediol, 1,2-nonanediol, and 1,2-decanediol) and the particular fragrance components is neither taught nor suggested.

This is because only the present specification discloses that the fragrance component such as eugenol can synergistically enhance the antibacterial activity which 1,2-alkanediol originally has against a broad range of strains (see paragraph [0062] and Figs 1 to 9 and [0073] in the present specification), because Clarkson et al. and Roetker et al. teach or suggest that a fragrance can be added to the composition only for the other purpose (e.g., covering odor) and because the “1,2-heptanediol, 1,2-nonanediol, and 1,2-decanediol” is not taught in the cited references.

Therefore, the combination of the particular 1,2-alkanediol and fragrance composition described in the amended claim 1 cannot be readily assumed by the person in the art.

With respect to claims 2 and 3, Applicants disagree with the rejection because there is no teaching or suggestion in the cited references, alone or in combination, of “one or more materials selected from the group of thymol, citronellal, terpinyl acetate, citronellol and β -pinene.” Because this limitation is not taught by even the combination of references, Applicants traverse the rejection of claims 2 and 3.

Claims 2 and 3 relate to an antiseptic disinfectant containing 1,2-alkanediol with 5-10 carbons and one or more materials selected from the group of thymol, citronellal, terpinyl acetate, citronellol and β -pinene.

Clarkson et al. discloses an anti-microbial composition comprising polyhydric alcohol or derivative to which may be added conventional perfumes (see [0086] in Clarkson et al.) and it is disclosed in Roetker et al. that eugenol can be contained in dry cleaning compositions to cover the inherent odor of the dry cleaning composition (10th line in column 4).

By referring to the above disclosures, the present invention described in the amended claims 2 and 3, thus a combination of the 1,2-alkanediol with 5-10 and the particular fragrance components is neither taught nor suggested.

This is because only the present specification discloses that the particular fragrance component can synergistically enhance the antibacterial activity which 1,2-alkanediol originally has against a broad range of strains (See [0062] and Figs 1 to 9 and [0073] in the present specification), because Clarkson et al. and Roetker et al. teach or suggest that a fragrance can be added to the composition only for the other purpose (e.g., covering odor) and because the particular fragrance components "thymol, citronellal, terpinyl acetate, citronellol and β -pinene are taught in the cited references.

Therefore the combination of 1,2-alkanediol and the particular fragrance composition described in the amended claims 2 and 3 cannot be readily assumed by the person in the art.

The amended claim 4 relates to cosmetics and toiletries comprising a cosmetically effective agent, 1,2-alkanediol with 5-10 carbons and one or more materials selected from a group of thymol, citronellal, terpinyl acetate, citronellol and β -pinene.

Clarkson et al. discloses an anti-microbial composition comprising polyhydric alcohol or derivative to which may be added conventional perfumes (See [0086] in Clarkson et al.) and it is disclosed in Roetker et al. that "eugenol" can be contained in dry cleaning compositions to cover the inherent odor of the dry cleaning composition. (In the 10th line in the column 4 in Roetker et al.)

By referring to the above disclosures, the present invention described in the amended claim 4, thus, a combination of the 1,2-alkanediol with 5-10 and the particular fragrance components cannot be readily assumed.

This is because only the present specification discloses that the particular fragrance component can synergistically enhance the antibacterial activity which 1,2-alkanediol originally has against a broad range of strains (See [0062] and Figs 1 to 9 and [0073] in the present specification) because the Clarkson et al. and Roetker et al. teach or suggest that a fragrance can be added to the composition only for the other purpose (e.g., covering odor) and because the particular fragrance components "thymol, citronellal, terpinyl acetate, citronellol and β -pinene are not taught in the cited references.

Therefore, the combination of 1,2-alkanediol and the particular fragrance composition described in the amended claim 4 cannot be readily assumed by the person in the art.

Therefore, the invention described in claim 4 should be seen as patentable over the cited references.

The amended claims 5 and 6 relate to cosmetics and toiletries comprising a cosmetically effective agent, one or more materials selected from a group consisting of 1,2-heptanediol, 1,2-nonanediol, and 1,2-decanediol and one or more materials selected from a group of thymol, citronellal, terpinyl acetate, citronellol and β -pinene.

Clarkson et al. discloses an anti-microbial composition comprising polyhydric alcohol or derivative to which may be added conventional perfumes (See [0086] in Clarkson et al.) and it is disclosed in Roetker et al. that eugenol can be contained in dry cleaning compositions to cover the inherent odor of the dry cleaning composition. (In the 10th line in the column 4 in Roetker et al.)

By referring to the above disclosures, the present invention described in the amended claims 5 and 6, thus, a combination of the particular 1,2-alkanediol (i.e., 1,2-heptanediol, 1,2-nonanediol, and 1,2-decanediol) and the particular fragrance components cannot be readily assumed.

This is because only the present specification discloses that the fragrance component such as eugenol can synergistically enhance the antibacterial activity which 1,2-alkanediol originally has against a broad range of strains (See [0062] and Figs. 1 to 9 and [0073] in the present specification) because Clarkson et al. and Roetker et al. teach or suggest that a fragrance can be added to the composition only for the other purpose (e.g., covering odor) and because the

particular 1,2-alkanediol “1,2-heptanediol, 1,2-nonanediol, and 1,2-decanediol” is not taught in the cited references.

Therefore the combination of the particular 1,2-alkanediol and fragrance composition described in the amended claims 5 and 6 cannot be readily assumed by the person in the art.

Therefore, there is no teaching in the cited combination of references of “one more materials selected from a group consisting of 1,2-heptanediol, 1,2-nonanediol, and 1,2-decanediol”. Because this limitation is not taught by even the combination of reference, the present invention described in the amended claims 5 to 6 should be seen as patentable.

With respect to claims 7-9, Applicants disagree with the rejection because there is no teaching in the cited combination of references of a medicinally effective agent. Because this limitation is not taught or suggested by the cited references, alone or in combination, Applicants traverse the rejection.

The amended claims 7 to 9 relate to medicine comprising a medicinally effective agent, 1,2-alkanediol with 5-10 carbons and particular fragrance components.

Clarkson et al. discloses an anti-microbial composition comprising polyhydric alcohol or derivative to which may be added conventional perfumes (See [0086] in Clarkson et al.) and not clearly mentions for what purpose the conventional perfumes may be added to the composition. However, it is suggested that the conventional perfumes described in Clarkson et al. can be added to the composition for the purpose of covering order because it is disclosed in Clarkson et al. that “the composition is used on the most malodorous areas of the human body, for example, the underarm areas or feet” (See [0001] in Clarkson et al.)

Roetker et al. discloses that eugenol can be contained in dry cleaning compositions in order to cover the inherent odor of the dry cleaning composition. (In the 10th line in the column 4 in Roetker et al.)

Thus, Clarkson et al. and Roetker et al. teach or suggest that a fragrance or perfume can be added to the composition only for covering odor.

Because there is no description that would have motivated the person in the art to add a perfume composition to medicine in the cited references, the present invention described in claims 7 to 9 is nonobvious over the cited references.

With respect to claims 10-12, Applicants disagree with the rejection because the Examiner has failed to present a reasonable suggestion to combine the references. Moreover, the suggestion to combine the cited references, as proposed by the Examiner, arises from Applicants' specification, and not from the cited references.

Applicants note that neither Roetker et al. nor Clarkson et al. provide any teaching or suggestion to use the compounds found therein in any food or edible substance. Roetker et al. is directed at dry-cleaning compositions; Clarkson et al. is concerned with antiperspirant for use on armpits and feet. Neither dry cleaning solutions nor antiperspirants are traditionally associated with food. The Examiner cites Jensen as teaching that anti-bacterial agents may be employed as effective preservative for food products, and the Examiner asserts that this would have suggested to one skilled in the art that the anti-bacterial agents of Roetker et al. and Clarkson et al. could be used with food.

However, Applicants submit that the above suggestion is not reasonable. Applicants admit that Jensen teaches some anti-bacterial agents that may be used with food. However, Jensen teaches anti-bacterial agents made only from *persea gratissima*, a derivative of avocado trees. Applicants note that there are millions of other anti-bacterial agents that exist, and there is seen no suggestion that the specific anti-bacterial agents of Roetker et al. or Clarkson et al. could be used with foods.

The Examiner concludes that it would have been obvious to use the antimicrobial composition as taught by Clarkson et al. and Roetker et al. in food products, because one would have been motivated to use the composition taught by Clarkson et al. and Roetker et al. in food products “because the anti-bacterial properties of 1,2-hexanediol and 1,2-octanediol can be used as a preservatives in food products to prevent spoilage and decomposition.”

However, the only teaching that the anti-bacterial properties of 1,2-hexanediol and 1,2-octanediol can be used as a preservatives in food products to prevent spoilage and decomposition is found in Applicants’ own disclosure. Applicants note that the Examiner may not use Applicants own disclosure as a suggestion to combine other references.

Therefore, Applicants disagree with the rejection of claims 10-12, and traverse it.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

Application No. 10/500,358
Attorney Docket No. 042276

Amendment under 37 C.F.R. §1.116
Amendment Filed: March 21, 2006

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Kenneth H. Salen

Attorney for Applicants

Registration No. 43,077

Telephone: (202) 822-1100

Facsimile: (202) 822-1111

KHS/rf